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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/821,754  | 04/09/2004  | John Edward O'Neill  | JEO-00101           | 1868             |
| 28960   | 7590        | 12/27/2006           | EXAMINER            |                  |
| HAVERSTOCK & OWENS LLP<br>162 NORTH WOLFE ROAD<br>SUNNYVALE, CA 94086 |             |                      | MENDIRATTA, VISHU K |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3711                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE                                |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS  |             | 12/27/2006           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                 |                      |  |
|------------------------------|---------------------------------|----------------------|--|
| <b>Office Action Summary</b> | Application No.                 | Applicant(s)         |  |
|                              | 10/821,754                      | O'NEILL, JOHN EDWARD |  |
|                              | Examiner<br>Vishu K. Mendiratta | Art Unit<br>3711     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 October 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12,33,34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12 rejected under 35 U.S.C. 102(b) as being anticipated by Weiss (4093237).

Claims 1,7,12: Weiss teaches a game board (Fig.2) comprising a plurality of game pieces, a plurality of first game pieces designated by a first type (Kings), a plurality of second game pieces designated by a second type (pawn), a plurality of third type game pieces designated by a third type (bishop), a plurality of forth type game pieces designated by a forth type (rooks), a plurality of fifth game pieces designated by a fifth type (knight), a plurality of sixth game pieces designated by a sixth type (queens), wherein all four queens are different in colors and further the game board comprising outer (peripheral) and inner squares.

The limitation “associated with” is treated as “rule for playing” and does not further limit the apparatus as claimed.

Claims 2,8: Weiss game board teaching all game piece types to be configured in different (K,Q,R,B,Kt,P).

Claims 3,9: Weiss game board having grid of squares (Fig.2) at least 8x8.

Claim 4: Weiss teaches outer perimeter and inner area of squares (Fig.2).

Claims 5,10: Weiss teaches a die as a randomizer means (4:38).

Claim 6,11: Weiss game pieces are capable of being designated as tree types.

Designations are intended use and not further limiting apparatus claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33,34 rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss. Weiss teaches all limitations except that it does not teach first type of game pieces in a specific shape. Examiner takes the position that game piece shapes are configured according to personal preferences that are aesthetically pleasing. The art area of game boards is an amusement art area and in order to attract players it would have been obvious to configure game pieces aesthetically pleasing. One of ordinary skill in art at the time the invention was made would have suggested configuring specific shapes for game pieces to attract potential players.

***Response to Arguments***

5. Applicant's arguments with respect to claims are not persuasive. The limitation "associated with" is treated as "rule for playing" and does not further limit the apparatus as claimed.

Examiner takes the position that Weiss teaches four sets of chess game pieces and all sets are in different color. King pieces = 1<sup>st</sup> type, Pawn pieces = second type, Bishop

pieces = third type, Rook pieces = fourth type, Knight pieces = fifth type, Queen pieces = sixth type, 1<sup>st</sup> queen piece = purple color, 2nd queen piece = red color, 3<sup>rd</sup> queen piece = blue color, 4<sup>th</sup> queen piece = green color.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711

VKM  
December 11, 2006

